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A significant advantage of this snow stop is that occasional misplacement on the roof is less noticeable, which saves time and money. This claim is fully supported in the specification in the sentence bridging pages 2-3; at page 3, lines 11-14; page 6, lines 13-25; page 9, lines 19-24; and in FIGS. 27-33.

Issue

The issue for review is whether claim 18 is unobvious over Smeja et al., US 5471799, in view of Francovitch, US 4467581, under the meaning of 35 USC 103(a).

Grouping of Claims

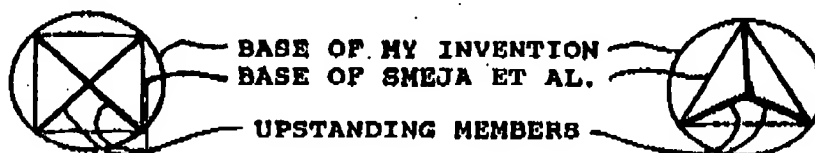
No other claim stands nor falls with claim 18.

Argument

In the record and in this paper, the Applicant traverses all grounds of rejection and statements adverse to the patentability of claim 18. The Applicant contends the following, moreover, in support of the patentability of this claim:

The reasoning to support the ostensible motivation to combine the references set forth by the Examiners is contrary to reason and law.

First, as any person of ordinary skill in the art would recognize, and as verified in the Third 37 CFR 1.132 Declaration filed on June 7, 2004, MORE, not LESS, material, and hence, MORE, NOT LESS, cost, is involved in making the snow stop with the round base than in making comparable snow stops disclosed by Smeja et al. See, the diagrams reproduced from that declaration:



This truth belies the specious reasoning that attempts to support the final rejection as set forth in Paper No. 20040921 on page 2.

Second, it is EXPRESSLY AGAINST controlling law to deem, as the Examiners have so far done, that cited art under Sec. 103(a) is "only required to disclose the claimed limitations," but is not to be related to the claimed invention. The quoted phrase represents law under Sec. 102, but NOT under Sec. 103(a). Thus, the still controlling case of In re Oetiker, 24 USPQ2d 1443 (Fed. Cir. 1992), states at page 1445:

"In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. [Citations omitted.]"

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COMMON SENSE is to prevail. See, Oetiker, 24 USPQ2d at 1446. The field of endeavor is snow stops, NOT "the roofing industry to prevent the entry of moisture into the structure." That the Examiners misapprehend the pertinent art is belied by this statement. A snow stop does not prevent the entry of moisture into the structure. It hinders the avalanche of snow from a pitched roof. If anything, by keeping snow and ice from sliding pell-mell off the roof and thus keeping it ON the roof, a snow stop might engender ENTRY of moisture into the structure! And so, the first prong of the Oetiker test for analogous art is not met. Nor is the second prong of the Oetiker test for analogous art met: Francovitch was concerned with anchoring a membrane roofing system to a roofing substructure to make it sound. The Applicant was concerned with providing a snow stop for an already sound, pitched roof to hinder the avalanche of ice and snow, and, significantly, ameliorating the situation where a snow stop is occasionally misplaced on the roof so as to make it less visibly noticeable, which saves much time and money. See, the present specification at page 3, lines 11-14, and the three declarations traversing rejections of record.

Such types of reasoning the Examiners rely on to support the rejection are exactly opposite to real world facts. They do not support a proper rejection. Oetiker, 24 USPQ2d at 1445-1446. Motivation is practical, not abstract. In re Newell, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Third, it is not enough for Smeja et al. to state, "base 10 is preferably square, although it could be other shapes," to motivate the ordinary artisan to provide a round based snow stop. The only other shape of base disclosed by Smeja et al. is another polygon, a triangle. Thus, Smeja et al. teaches to polygonally shaped bases such as a triangle or square. And so, Smeja et al. teaches away from a round base. This is STRONG evidence of unobviousness. In re Hedges, 228 USPQ 685, 687 (Fed. Cir. 1986). Moreover, such a statement does not even rise to the level of general guidance, but general guidance is not sufficient to establish a case of obviousness. See, In re Roemer, 59 USPQ2d 1527, 1531 (Fed. Cir. 2001). Thus, the Board of Patent Appeals and Interferences held under Sec. 102 (and the Examiner afterward admitted under Sec. 103(a)) in prosecution of an application in which the very same argument was proposed by the Examiner under Secs. 102 and 103(a) to reject claims of an applicant and stated:

"While [the patent] does teach that the surface treatments may be located anywhere ... [it] does not teach ... providing a ... [surface treatment] on the peripheral side faces ..."

See, DECISION ON APPEAL mailed MAR 19 2003 (Paper No. 26), pages 7-8, of application No. 09/408,409 (Appeal No. 2002-2198), which issued as patent No. 6,695,994 B1 (Feb. 24, 2004). In that case, under the selfsame reasoning in a rejection under Sec. 103(a) made subsequent to the decision of the Board, the Examiner was reminded -- as are the present Examiners -- that obviousness cannot be predicated on that which is unknown. Note, In re

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Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). In the present case, there is no knowledge of a round-based snow stop of record, save that of the Applicant.

To apply the Applicant's invention disclosure, however, against his claim as if it were a prior art reference, or to take elements of the claim found in bits and pieces of unrelated prior art, as the Examiners have done in the present case, constitute examples of mere exercises in attempted hindsight reconstruction of the claim, and are strictly prohibited. Citations omitted.

Finally, if needed, evidence of patentability, to include that of secondary considerations, verified by Mr. Mullane MUST be given weight. It must not be ignored. Citations omitted.

The reasoning set forth in the action is in serious error.

Relief Requested and Other Matters

Withdrawal of the final rejection is in order and requested.

Thank you for acting upon the Form PTO-1449 substitute.

Thus, the present application is in condition for allowance. Yet, the Examiner is invited to call the undersigned to discuss the case, or to seek authorization for an Examiner's amendment.

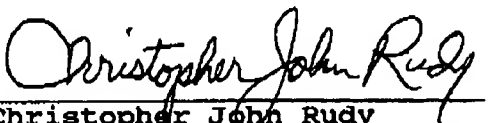
Prompt action with the issue of a Notice of Allowance is earnestly solicited.

Respectfully,

MICHAEL J. MULLANE

Dated: Dec. 20, 2004 A.D.

By


Christopher John Rudy
PTO Registration No. 31,873
209 Huron Avenue, Suite 8
Port Huron, Michigan 48060
Telephone (810) 982-4221